



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
087801.464	02/18/97	FUNAKOSHI	CFO-11946-US

805514
FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK NY 10112-3801

QM11/0406

EXAMINER
DEXTER, C

ART UNIT 3724	PAPER NUMBER
------------------	--------------

DATE MAILED: 04/06/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.

08/801,464

Applicant(s)

Funakoshi et al.

Examiner

Clark F. Dexter

Group Art Unit

3724

☒ Responsive to communication(s) filed on Apr 20, 1998☐ This action is **FINAL**.☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims☒ Claim(s) 1-18 is/are pending in the application.Of the above, claim(s) 2, 5, and 13-18 is/are withdrawn from consideration.☐ Claim(s) _____ is/are allowed.☒ Claim(s) 1, 3, 4, and 6-12 is/are rejected.☐ Claim(s) _____ is/are objected to.☐ Claims _____ are subject to restriction or election requirement.**Application Papers**☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.☐ The drawing(s) filed on _____ is/are objected to by the Examiner.☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.☒ The specification is objected to by the Examiner.☐ The oath or declaration is objected to by the Examiner.**Priority under 35 U.S.C. § 119**☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been☒ received.☐ received in Application No. (Series Code/Serial Number) _____.☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).**Attachment(s)**☒ Notice of References Cited, PTO-892☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 6☐ Interview Summary, PTO-413☐ Notice of Draftsperson's Patent Drawing Review, PTO-948☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 3724

DETAILED ACTION

Election/Restriction

1. Applicant's election with traverse of group III (claims 1, 3, 4 and 6-11) in the response filed April 20, 1998 (paper #8) is acknowledged. The traversal is on the ground(s) that all of the claims could be searched by one examiner without undue effort. This is not found persuasive because, contrary to applicant's opinion, an undue burden is placed on the examiner in having to search and consider all of the subject matter of all of the claims in the time available. Further, applicant's statements that "if one Examiner acts on all of the claims, overall examining time will be less than if multiple Examiners are involved", and that "examination of all of the claims by one Examiner in the present application will best ensure uniform prosecution quality" are beyond the scope of this restriction, since the issue of the restriction is which inventions are present, not who will examine each invention. However, applicant's position regarding a single Examiner prosecuting all of the claims will be further considered upon prosecution of the non-elected inventions. The requirement is still deemed proper and is therefore made FINAL.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Art Unit: 3724

Information Disclosure Statement

3. The information disclosure statement filed February 18, 1997 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. Specifically, the copy of European Patent Application 0 660 421 A2 along with the abstract therefor has been received, but the copy of the EP publication is incomplete because Figures 1-18 (pages 43-58) are missing. It has been placed in the application file, but the information referred to therein has not been considered.

Specification

4. The disclosure is objected to because of the following informalities:

On page 14, line 16, "like a plane" is unclear.

On page 17, lines 1-6 are awkwardly worded.

On page 18, line 27, it seems that "guide line" should read --common line 106--.

On page 22, lines 14-15, "groove notch" is unclear and it seems that it should read "notch" should be deleted; in line 21, "stage groove portion" is unclear, and it seems that it should read --groove--.

On page 26, line 23, "like a plane" is unclear.

On page 27, line 1, "can be improved is obtained" is unclear; in line last line, "like" is unclear. Appropriate correction is required.

Art Unit: 3724

Claim Rejections - 35 USC § 112

5. Claims 3 and 9 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification and drawings do not appear to provide support for forming the guide line, specifically, forming the guide line simultaneously with the slice line as set forth in claim 3. ←

Similarly, the specification and drawings do not appear to provide support for forming the electrode layer, specifically, forming the electrode layer simultaneously with an electrode line as set forth in claim 9. ←

6. Claims 1, 3, 4 and 6-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 1, the preamble is unclear and it is not clear as to what is the claimed invention, and it seems that "of" should read --comprising-- or the like; in line 2, "in correspondence to" is vague and indefinite as to what is being set forth.

In claim 8, lines 1-2, "said electrode layer" is vague as to which one; in line 3, "an electrode line" is vague and indefinite as to what disclosed structure it refers. ←

Art Unit: 3724

In claim 9, lines 1-2, ✓ “said electrode layer” is vague as to which one; in line 3, “an electrode line” is vague and indefinite as to what disclosed structure it refers. ←

Claims 11 ✓ and 12 are vague and indefinite as to what method is being claimed, particularly ← since there are no active method steps.

In claim 11, line 5, ✓ “said cutting” lacks antecedent basis.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 3, 6 and 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Schmale.

Schmale discloses a cutting method with every active step of the claimed process including detecting a position of a guide line, and cutting a substrate along a slice line. It is noted that the limitations set forth in claims 12 and 13 have been given little or no patentable weight since there are not active steps set forth to define the claimed process.

Art Unit: 3724

Allowable Subject Matter

9. Claims 4 and 7-9 appear that they would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112 set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark Dexter whose telephone number is (703) 308-1404.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Rinaldi Rada, can be reached at (703)308-2187.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-1148. The fax numbers for this group are: formal papers - (703)305-3579; informal/draft papers - (703)305-9835.

Communications via Internet e-mail regarding this application, other than those under 35 USC 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [rinaldi.rada@uspto.gov].

Art Unit: 3724

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 USC 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark Office on February 25, 1997 at 1195 OG 89.



Clark F. Dexter
Primary Examiner
Art Unit 3724

cf
March 29, 1999